



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,942	04/13/2004	Haruhiko Nitta	19036/38371A	4425

4743 7590 03/22/2005

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,942

Applicant(s)

NITTA ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 404, 105.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The first line of applicants' specification recites that the present application is a continuation-in-part of 10/152,603. This information is inconsistent with Office records which indicate that Serial No. 10/152,603 was filed on 5-21-02. Correction is required. It is noted that once applicants make their correction that the specification will be inconsistent with applicants' application datasheet. Therefore applicants should file another application datasheet.

Serial No. 10/152,603 to which applicants claim priority does not disclose a Type A Durometer hardness of A30-A50 nor does it disclose "reducing plastic deformation" for an ethylene-propylene diene copolymer for sufficient elasticity or polystyrene for reducing plastic deformation or component "e" for sufficient elasticity as recited by claim 1. Therefore the full scope of the instant claims is not supported by the parent case and as such the effective filing date of the present case is that of the actual filing date, namely 4-13-04. Furthermore applicants' amounts recited in the instant claims of 50-90 parts by weight of "d" are totally and completely out of the range of polystyrene recited by the parent case and do not even overlap.

Claims 1 and 2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants

regard as the invention.

The second paragraph of claim 1 recites "10 to 50 parts by weight of (c)" despite the fact that c is not mentioned up until the point at which "10 to 50 parts by weight of (c)" are recited.

It is therefore unclear what "d" is in the second paragraph of claim 1.

The specification is objected to since it does not provide proper antecedent basis for claim 1 which recites "an ethylene-propylene copolymer or an ethylene-propylene diene copolymer for sufficient elasticity". If applicants are going to leave this subject matter in the claims, they should insert it into the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nita et al. (published U.S. Patent Application 2003/0065094).

Paragraph 32 of the published application in Table 1 thereof shows a composition containing all of applicants' components in applicants' amounts and having a Type A Durometer hardness of A40 for producing a roller.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okuyama et al. (EP 924258), cited by applicants.

Okuyama et al. in Example 8 disclose a composition containing a combination of polypropylene/EPDM which is dynamically vulcanized (note paragraph 45) and a hydrogenated styrene isoprene styrene block copolymer in applicants' proportions. Note Table 1 on page 9. The material is used to make rollers. Note paragraph 1. While the instant claims refer to the composition recited therein as being "on its outer periphery" with regard to the paper feeding roller, patentees at paragraph 42 disclose that the surface of the paper feeding

roller is polished and refer to the hydrogenated styrene thermoplastic elastomer as being polished also and therefore implies that the surface of the roller also contains patentees' composition. With regard to applicants' specific amounts of hard segment in the styrene based thermoplastic elastomer (corresponding to the amount of styrene in patentees' elastomer), note paragraph 49 where it is disclosed that the material Septon 2023 is used in Experiment 9. Note Kinoshita et al. (U.S. 6,747,094) who discloses that Septon 2023 has 13% styrene at column 22 lines 17-20.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be

Serial No. 10/822,942

-6-

Art Unit 1711

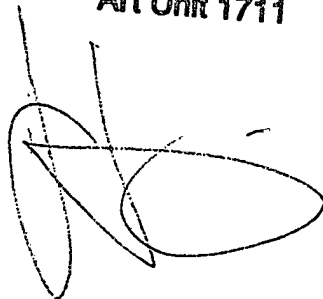
reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

March 17, 2005

**Jeffrey Mullis
Primary Examiner
Art Unit 1711**

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line and a loop.